

## **REMARKS**

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, claims 28-54 were pending in the application, of which claims 28 and 46 are independent. In the Office Action mailed June 19, 2006, the Examiner rejected claims 28-29, 35-37, 39, and 41-45 under 35 U.S.C. § 102(b) and claims 30-34, 38, 40, and 46-54 under 35 U.S.C. § 103(a). Following this response, claims 28-54 remain pending in this application. Applicant hereby addresses the Examiner's objections and rejections in turn.

### **I. Objections to the Drawings**

The Examiner objected to Figure 2a, stating that it lacks proper cross-hatching indicating the type of materials comprising the embodiment of the invention depicted in Figure 2a. Applicant has submitted a replacement Figure 2a, attached hereto, addressing the Examiner's objection. Applicant believes the replacement Figure 2a overcomes the Examiner's objection and requests approval of the replacement figure.

### **II. Objection to the Specification**

The Examiner objected to lines 6-7 of the abstract as originally filed. Applicant has amended the abstract to remove the material objected to by the Examiner. Accordingly, Applicant believes the objection has been overcome.

### **III. Rejection of the Claims Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 28-29, 35-37, 39, and 41-45 under 35 U.S.C. § 102(b) as being anticipated by German Patent Number 27 10620 ("Siewerth"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131;

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Because Siewerth does not teach every element recited in claim 28, it does not anticipate claim 28 or any of dependent claims 29, 35-37, 39, or 41-45.

Claim 1 recites, among other things, "electrical contact elements electrically connecting said base and said cover, wherein said electrical contact elements are selected from the group of metal fusion joints and resilient members suitable to penetrate said ferromagnetic material." The Examiner asserts that the individual bars 5 of the netting 3 comprising the cage 1, shown in Figure 1 of Siewerth, meet this limitation. However, Applicant traverses this rejection because Siewerth's individual bars 5 do not form electrical contact elements electrically connecting the base and the cover of the cage shown in Siewerth's Figure 1.

Siewerth discloses that the top cover 4 and the cage 1 forming a conduit do not need to be in close contact. Siewerth at p. 7. Figure 3 of Siewerth, which shows a cross-section of the cage illustrated in Figure 1 (Siewerth at p. 6), illustrates that the cover is not electrically connected with the base. Siewerth emphasizes this by disclosing that the individual bars 5 are "totally encased in a protective coating 8, as illustrated in Fig. 2." Siewerth at 7. The possible materials Siewerth discloses for the protective coating 8 are all poor electrical conductors: bitumen, plastic, read lead, concrete, and lead. *Id.* Thus, contrary to the Examiner's assertion, the individual bars 5 of Siewerth are not electrical contact elements electrically connecting the base and the cover. Furthermore, Siewerth does not disclose that the individual bars 5 are either metal fusion joints or resilient members suitable to penetrate ferromagnetic material. Accordingly, because Siewerth does not disclose each element recited in claim 28,

Applicant respectfully requests that the rejection of claim 28, as well as dependent claims 29, 35-37, 39, and 41-45, under 35 U.S.C. § 102(b) be withdrawn.

IV. Rejection of the Claims Under 35 U.S.C. § 103(a)

The Examiner rejected claims 31-34, 38, 40, 46-51, and 53-54 under 35 U.S.C. § 103(a) as being obvious over Siewerth. However, a *prima facie* case of obviousness is established only if the prior art cited by the Examiner teaches or suggests each limitation of the rejected claim. MPEP 2142. Because Siewerth does not teach or suggest every limitation recited in claims 31-34, 38, 40, 46-51, and 53-54, Applicant respectfully asserts that a *prima facie* case of obviousness has not been established.

As discussed above in regard to the Examiner's rejection under 35 U.S.C. § 102(b), Siewerth does not teach or suggest "electrical contact elements electrically connecting said base and said cover, wherein said electrical contact elements are selected from the group of metal fusion joints and resilient members suitable to penetrate said ferromagnetic material," as recited in claim 28. Accordingly, a *prima facie* case of obviousness has not been established with regard to claim 28, or claims 31-34, 38, or 40, each of which depend from claim 28. Applicants therefore respectfully request that the rejection of those claims be withdrawn.

With regard to claim 46, the Examiner acknowledges that Siewerth does not disclose the following recitation of claim 46: "providing an electrical connection between said base and said cover having a conductance, per meter of length, of at least 150 Siemens/m." The Examiner asserts that it would have been obvious to one of ordinary skill to modify the disclosure of Siewerth to have a conductance between the cover and the base of a conduit of 150 Siemens/m. However, a prior art reference must be

considered as a whole, including portions that would lead away from the claimed invention. MPEP 2141.02. As discussed above, Siewerth does not teach or suggest an electrical connection between the base and the cover of a conduit. In fact, Siewerth expressly teaches away from such a connection: "all individual bars 5 of the pieces of netting 3 are totally encased in a protective coating 8, as illustrated in Fig. 2." Siewerth at 7. Similarly, Siewerth states that "the top covers 4 do not need to be in close contact with the cage 1 in order for the protection system to operate at its maximum effect." *Id.* This is illustrated in Siewerth's Figure 3, which confirms that no electrical connection exists between the cover and the base. Accordingly, as Siewerth does not teach or suggest providing an electrical connection between the base and the cover of a conduit, and in fact teaches away from such a connection, a *prima facie* case of obviousness has not been established with regard to claim 46. Therefore, Applicant respectfully requests that the rejection of claim 46, as well as dependent claims 47-51 and 53-54, as being obvious over Siewerth be withdrawn.

With specific regard to the Examiner's rejection of dependent claim 50, the Examiner asserts that Siewerth discloses providing an electrical connection between the base and the cover of a conduit through a metal fusion between the base and the cover, citing page 6 of Siewerth. Applicants respectfully traverse the Examiner's assertion, however, as Siewerth merely teaches that sequential sections of the base may be joined to one another. Nothing in the cited passage teaches a metal fusion between the base and the cover. In fact, the passage of Siewerth cited by the Examiner expressly teaches that it is not necessary to provide metal fusion between the base and the cover of the conduit: "There is no need to provide a fixed connection between the

top covers 4 and the cage 1, such as welding.” Siewerth at 7. For this additional reason, Applicant requests that the rejection of claim 50 be withdrawn.

The Examiner also rejected claims 30 and 52 under 35 U.S.C. § 103(a) as being obvious over Siewerth in view of German Patent Number 3,447,836A1 (“Fasterding”). The Examiner acknowledges that Siewerth does not disclose claim 30’s recitation of “wherein resilient members are clips provided with portions able to penetrate said ferromagnetic material,” but asserts that the abstract of Fasterding teaches this limitation. The Examiner also asserts that Fasterding teaches the similar limitation of claim 52 “wherein electrically coupling said lateral portions comprises applying to said lateral portions a plurality of metal resilient clips able to pierce the surface of said lateral portions under their elastic action.” However, while the abstract of Fasterding teaches a trough and lid formed of sheet steel, it does not teach or suggest that elements 6, best shown in Figure 2, form an electrical connection between the trough and the lid. Furthermore, the abstract of Fasterding does not disclose that the elements 6 comprise portions able to penetrate said ferromagnetic material as recited in claims 30 and 52. Accordingly, the combination of Siewerth and Fasterding does not teach or suggest each limitation of claims 30 and 52.

In any case, Siewerth and Fasterding cannot properly be combined because Siewerth teaches away from the modification suggested by the Examiner. Siewerth teaches that “[t]here is no need to provide a fixed connection between the top covers 4 and the cage 1, such as welding. Similarly, the top covers 4 do not need to be in close contact with the cage 1 in order for the protection system to operate at its optimum effect.” Siewerth at 7; see *also* Fig. 3. Thus, because Siewerth expressly teaches that

it is not necessary to have a connection between the lid and the base of the conduit of the type disclosed by Fasterding, there is no motivation to modify Siewerth in the manner suggested by the Examiner. For these reasons, no *prima facie* case of obviousness has been established with regard to claims 30 or 52.

V. Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address other patentable aspects of the invention. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

If there are any fees due in connection with the filing of this preliminary amendment, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to our deposit account.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 6, 2006

By: 

Courtney S. Alexander  
Reg. No. 54,778